

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte EDWIN H. WEGMAN, BURTON BRONSTHER  
and ERWIN T. JACOB

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Appeal No. 2001-0638  
Application 08/757,904

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ON BRIEF

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**MAILED**

**AUG 30 2002**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before WINTERS, ADAMS and MILLS, Administrative Patent Judges,

MILLS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-21, which are the claims pending in this application.

Claim 1 is representative of the claims on appeal and reads as follows:

1. A method of reducing for cosmetic purposes the amount of adipose tissue at selected locations in the body which comprises introducing into said tissue effective amounts of collagenase or collagenase plus another proteinase, said adipose tissue comprising connective tissue and fat, said collagenase digesting said connective tissue,

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and the body metabolizing fat released from said adipose tissue whereby the amount of adipose tissue at said selected locations is reduced for cosmetic purposes.

19. The method according to claim 16, wherein reduction of said tissue from its original volume ranges from 25% to 75%.

The references relied upon by the examiner are:

Lee et al. (Lee)                      5,424,208                      Jun. 13, 1995

Guidicelli et al. (Giudicelli), "Influence of trypsin on lipolysis in human fat cells comparison with rat adipocytes." Biochimica et Biophysica Acta, Vol. 450, pp. 358-366 (1976)

#### Grounds of Rejection

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as obvious over Lee in view of Giudicelli.

#### Grouping of Claims

According to appellants, the "claims of group 1-21 do not stand or fall together. Claims 19 and 21 as a group are believed to be separately patentable from the other claims." Brief, page 3. For the purposes of this appeal we have considered claims 2-18 and 20 as standing and falling with claim 1. Claims 19 and 21 are treated separately. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

### DISCUSSION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Examiner's Answer for the examiner's complete reasoning in support of the rejection, and to the appellants' Brief and Reply Brief for the appellants' arguments thereagainst. As a consequence of our review, we make the determinations which follow.

#### 35 U.S.C. § 103

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as obvious over Lee in view of Giudicelli.<sup>1</sup>

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested

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<sup>1</sup> We find it confusing that the examiner states in the Answer, page 3, that the obviousness rejection is based on Lee combined with Giudicelli. Further discussion in the Examiner's Answer indicates that the references are not combined and thus Giudicelli is not relied on for the purpose of resolving deficiencies found in Lee. Thus, purposes of this appeal, we treat the obviousness rejection as based on either Lee or Giudicelli.

the claimed subject matter to a person of ordinary skill in the art. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). An obviousness analysis requires that the prior art both suggest the claimed subject matter and reveals a reasonable expectation of success to one reasonably skilled in the art. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

It is the examiner's position that Lee teaches administering collagenase plus chymopapain to digest connective tissue. Adipose tissue is particularly disclosed as being effectively digested so as to obtain endothelial cells present therein. Answer, page 3. Giudicelli discloses that it is conventional to administer and use collagenase and trypsin for the purpose of digesting and isolating adipocytes. Id. The examiner suggests that the teachings of Lee are indicated to be widely applicable to a number of tissue digestion procedures including those which involve in vivo digestion. The examiner acknowledges that while in vivo digestion of adipose tissue was not expressly disclosed, the teaching of the patent is not limited to its preferred embodiments. Answer, page 4.

The examiner finds (Answer, page 4) that one of ordinary skill in the art would expect that, should he/she wish to reduce the amount of any connective tissue, including adipose tissue, at a site in the body, one would be motivated to use a composition well known to digest said tissue with a reasonable expectation of success. With respect to the claim language "for cosmetic purposes" the examiner finds this language fails to distinguish over procedures such as Lee et al.

In our view the present claims require only one positive manipulative step, that of introducing into adipose tissue effective amounts of collagenase or collagenase plus another proteinase. In the claimed method, as well as the methods of Lee and Giudicelli, the agent which is introduced into the body is the same, and the tissue into which the agent is introduced is the same, adipose tissue. While it may not be readily apparent from reading Lee and Giudicelli that the body metabolizes the fat released from the adipose tissue, such would appear to be an unrecognized benefit of the prior art processes of Lee and Giudicelli.

It is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable. In re Woodruff, 919 F.2d 1575, 1577-78, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990); Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 632-33, 2 USPQ2d at 1054 ; Bird Provision Co. v. Owens Country Sausage, Inc. 568 F.2d 369, 375, 197 USPQ 134, 139 (5th Cir. 1978); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971); and Ex Parte Novitski, 26 USPQ2d 1389, 1391 (Bd. Pat. App. & Int. 1993). In the present case, the single active manipulative step recited in the claims is clearly met by the disclosures of Lee and Giudicelli. Any new benefit, such as reducing the amount of adipose tissue at selected locations, related to these old processes cannot render such process again patentable.

Nor do we find the fact that Lee may have introduced collagenase into adipose tissue, or connective tissue comprising adipose tissue for a different purpose (recovery of microvessels) to be a convincing argument in favor of patentability of the claimed

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method. See In re Hoch, 428 F.2d 1341, 1343, 166 USPQ 406, 409 (CCPA 1970) (Court rejected appellant's argument that a prima facie case of obviousness necessarily has been overcome merely because his compounds possess an advantageous (unexpected) property in view of the prior art. "Actual differences in properties are required to overcome a prima facie case of obviousness because the prima facie case ... is based on the expectation that compounds which are very similar in structure will have similar properties ...".) Compare In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) (In establishing a prima facie case of obviousness, the motivation to combine references provided by the examiner does not have to be identical to applicant's to establish obviousness.)

Appellants argue that the purpose or intended use of their method is different from that of Lee and Giudicelli and not suggested by either of these cited references. Language in a claim preamble, such as reducing the amount of adipose tissue at selected locations, however, acts as a claim limitation only when such language serves to "give meaning to a claim and properly define the invention," not when the preamble merely states a purpose or intended use of the invention. In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (quoting DeGeorge v. Bernier, 768 F.2d 1318, 1322 n.3, 226 USPQ 758, 766 n.3 (Fed. Cir. 1985)). "If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim." IMS Technology, Inc. v. Haas

Automation, Inc., 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1137 (Fed. Cir. 2000). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim. . . . If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation." Pitney Bowes Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). In the present case, the claim preamble recitation that the method reduces the amount of adipose tissue at selected locations, does not reasonably appear to further limit claims as it merely states a purpose or intended use of subject matter.

Appellants further argue that the cited references fail to teach the claimed recitation that the "body metabolizes the released fat whereby the amount of adipose tissue at said selected locations is reduced." The appellants argue that both Lee and Giudicelli teach that the fat cells remain intact, citing Lee, column 8, lines 45-51 and column 11, lines 22-27, Giudicelli, page 359, third paragraph. Again where the prior art shows the agent which is introduced into the body is the same, and the tissue into which the agent is introduced is the same, adipose tissue, and there is a suggestion of in vivo use, there is reason to believe that the functional features of fat metabolism are the

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same. The burden is properly shifted to appellants to show that such fat metabolism does not occur in the in vivo method of Lee.

Appellants' burden under the circumstances presented herein was described in In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), quoting In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971):

[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [58 CCPA at 1031, 439 F.2d at 212-13, 169 USPQ at 229.] This burden was involved in In re Ludtke, 58 CCPA 1159, 441 F.2d 660, 169 USPQ 563 (1971), and is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics.

With respect to claims 19 and 21, reciting a percentage of fat reduced, we find the burden of appellants is the same as that with respect to the independent claims which state that adipose tissue is reduced. We find, in each case, appellants have failed to prove that the prior art processes do not necessarily or inherently possess the characteristics of his claimed process, such as reducing adipose tissue 25%, to rebut the examiner's prima facie case of obviousness with sufficient evidence.



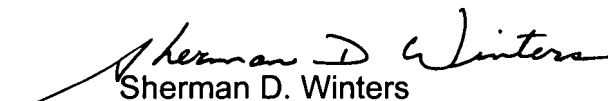
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CONCLUSION

The rejection of claims 1-21 under 35 U.S.C. § 103(a) as obvious over Lee in view of Giudicelli is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

  
Sherman D. Winters  
Administrative Patent Judge

  
Donald E. Adams  
Administrative Patent Judge

  
Demetra J. Mills  
Administrative Patent Judge

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